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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,745	08/07/2001	Mario D'Amico	13742	1926

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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/922,745	D'AMICO, MARIO	
	Examiner	Art Unit	
	Nathan Hillery	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 11/24/04.
2. Claims 1 – 22 are pending in the case. Claims 1, 13, 15, 19 and 21 are independent.
3. The rejection of claims 1 – 15 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) and further in view of Rodkin et al. (US 6687878 B1).
6. **Regarding independent claim 1**, Eintracht et al. teach that *the present invention is a system for collaborative document annotation whereby notes or annotations associated with a document are stored on a web server. Examples of documents include, but are not limited to, images, text documents or documents expressed in a page description language such as Postscript or Adobe PDF. In addition, each document may contain more than one page, wherein each page is annotated independently of the other. The documents and associated annotations are treated independently from each other. Separate data structures are created for the documents and for the associated annotations thus permitting their independent*

management (Column 6, lines 32 – 43), which provide that a. a first set of data causing the browser to render on the display a fixed representation of a document; b. a second set of data which causes the web browser to make available to the user at least one annotation tool donating to the web browser an annotation functionality, said annotation tool permitting a user to annotate the fixed representation of the document by invocation of one or more methods of the document object model that manipulate HTML. Eintracht et al. do not explicitly teach *manipulating HTML*. However Rodkin et al. do teach that *the term <a> is HTML which designates a hypertext anchor. The Intelligent Annotator.TM. 520 associates anchor codes and corresponding destination addresses with the matched character strings. In one embodiment, the Intelligent Annotator.TM. 520 inserts anchor codes into the annotated article 415 to identify the corresponding destination address in the destination and expiration database 540. Alternatively, relational database techniques may be used (Column 16, lines 60 – 67), which provide at least one method to manipulate HTML.* It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Eintracht et al. with that of Rodkin et al. because such a combination would provide the users of Eintracht et al. the benefit of a *method and apparatus for automatically providing hypertext anchor codes and destination addresses for a user-readable text file at a content server (Column 3, lines 60 – 64).*

7. **Regarding dependent claim 5**, Eintracht et al. teach that *an annotation or note is a portion of text or a graphical drawing that is associated with a specific location in a*

*document. The terms annotation and note are intended to mean the same thing and are used interchangeably throughout this document. The location associated with a note in the document is called a Note Anchor and is kept separate from the annotation data itself. Once a note is created, its anchor point can be changed by the user. The note anchor is expressed in terms of (X, Y) coordinates in the annotated page of a document. A note anchor may be set to a coordinate value of (0, 0) if the document associated with the note is a logical folder. Note that the annotation can be displayed within its own window or can be layered on top of the displayed document. The first option is used in the case of text only annotations. The second option is used for mixed text and graphical annotations (Column 7, line 55 – Column 8, line 3), which provide that **use of the annotation tool invokes one or more methods of the object model that manipulate HTML to generate HTML annotation data constituting a layer to the fixed representation of the document.***

8. ***Regarding dependent claim 6**, Eintracht et al. teach that at the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each (Column 2, lines 53 – 55), which provide that **the HTML annotation data includes an annotation image element and coordinates information specifying the position of the annotation image element in the fixed representation of the document.***

9. ***Regarding dependent claims 7 – 9**, Eintracht et al. teach that each record in the Notes Table of the Notes Database 60 utilizes the unique Note Serial Number for the key index. Each record in the database comprises the following information: Note*

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*Document ID, Note Contents (text or graphical information), Note Anchor coordinates, Note Time Stamp and Note Owner ID (Column 10, lines 56 – 61), which provide that **the HTML annotation data includes identity data identifying an author of the annotation data, the HTML annotation data includes a data stamp, and the HTML annotation data includes a time stamp.***

10. ***Regarding dependent claims 10 – 12**, Eintracht et al. teach that *the document may contain one or more pages. An example for a single page document is a TIFF file format image. An example of a multi-page document is an Adobe Portable Document Format (PDF) document (Column 12, lines 50 – 53), which provide that **the document includes multiple pages, that the fixed representation of the document is a representation of the document in printed form (PDF), and that the first set of data includes data in a format selected in the group consisting of GIF, JPEG, TIFF representing the document in printed form.****

11. ***Regarding independent claim 13**, the claim incorporates substantially similar subject matter as claims 1 and 5, and is rejected along the same rationale. Further, regarding the added limitation, **appending the HTML annotation data to the file**, Eintracht et al. teach that *immediately thereafter, the client issues a request to retrieve the notes associated with the image, if there are any, from the server (step 124). The URL that is supplied to the server to retrieve the notes is the same URL corresponds to the underlying document (image) but having a suffix of ``.backslash.notes`` appended to it. Upon receiving the appended URL, the server searches the Notes Database 60 (FIG. 3) for the specified document using the URL as the key for searching (step 126).**

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Once found, the server filters the notes so as to supply only those notes that the requesting client has permission to view (step 128). (Column 13, line 66 – Column 14, line 9).

12. **Regarding dependent claim 14**, Eintracht et al. teach that *the Notes Server 58 functions to provide the central document and note management features. Normally the Notes Server functions in conjunction with a web server 54. It may access documents that reside in its own file system or that reside on remote file servers 62 located within the local area network* (Column 8, lines 33 – 38) and that *note Events are exchanged between the server and the clients. Notes Clients forward to the Notes Server requests to view, modify, create or delete notes. In response, the Notes Server Updates the clients with an up to date note list per document* (Column 9, lines 16 – 20), which provide for **establishing a communication with a remote server and forwarding to the remote server the file to which is appended the HTML annotation data.**

13. **Regarding independent claim 15**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

14. Claims 2 and 16 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) and Rodkin et al. (US 6687878 B1) as applied to claims 1, 5 – 15 above, and further in view of Madrane (US 6573907 B1).

15. **Regarding dependent claims 16 – 18**, neither Eintracht et al. nor Rodkin et al. explicitly teach **DHTML**. However, Madrane teaches that *Microsoft's DHTML editor is the preferred one* (Column 29, line 19), which provides that **the document object**

model has at least one method to manipulate DHTML. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Eintracht et al. and Rodkin et al. with that of Madrane because such a combination would allow the users of Eintracht et al. and Rodkin et al. the benefit of a *managing media files, creating and authoring media containers, publishing and indexing media containers, searching and browsing media containers, and distributing media containers* (Column 1, lines 11 – 14).

16. ***Regarding dependent claim 2,*** Eintracht et al. do not explicitly teach ***generating HTML data.*** However Rodkin et al. do teach that *the term <a> is HTML which designates a hypertext anchor. The Intelligent Annotator.TM. 520 associates anchor codes and corresponding destination addresses with the matched character strings. In one embodiment, the Intelligent Annotator.TM. 520 inserts anchor codes into the annotated article 415 to identify the corresponding destination address in the destination and expiration database 540. Alternatively, relational database techniques may be used* (Column 16, lines 60 – 67), which provide that ***use of the tool for annotating the fixed representation of the document invokes at least one method of the object model for generating HTML data.*** It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Eintracht et al. with that of Rodkin et al. because such a combination would provide the users of Eintracht et al. the benefit of a *method and apparatus for automatically providing hypertext anchor codes and destination addresses for a user-readable text file at a content server* (Column 3, lines 60 – 64).

17. Claims 3 and 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1), Rodkin et al. (US 6687878 B1) and Madrane (US 6573907 B1) as applied to claims 2 and 16 – 18 above, and further in view of Zhu (cited by App).

18. **Regarding dependent claims 3 and 4**, neither Eintracht et al., Rodkin et al., and Madrane explicitly teach **a pen tool, a highlight tool and a notes tool**. However, Zhu teaches that *referring to FIG. 2, when the user starts the overlay program, a window is created and a default object type, such as the pen type, is provided. The user can use the pen, the movement of which is controlled via the mouse, to move around the screen and click on icons. The user can click on an icon to import one or more images and display them on the screen 24. The user can create annotation objects on the images with the pen (Column 5, lines 19 – 26) and that the user may create annotation objects by first selecting the annotation object type (or use the default annotation object type) to annotate over the image. Annotation object types include highlights, boxes, circles, lines, arrows, text input, and etc. (Column 5, lines 44 – 48), which provide that **said second set of data causes the web browser to make available to the user a plurality of annotation tools, said annotation tools being independently selectable by the user for annotating the fixed representation of the document**, and that **the plurality of annotation tools include a pen tool, a highlight tool and a notes tool (text input)**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Zhu with*

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that of Eintracht et al., Rodkin et al., and Madrane because such a combination would provide the users of Eintracht et al., Rodkin et al., and Madrane the benefit of a *method for organizing and accessing screen presentation to a computer display* (Column 2, lines 49 – 50).

19. Claims 19 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) and further in view of Madrane (US 6573907 B1).

20. ***Regarding independent claims 19 and 21***, Eintracht et al. teach that *the present invention is a system for collaborative document annotation whereby notes or annotations associated with a document are stored on a web server. Examples of documents include, but are not limited to, images, text documents or documents expressed in a page description language such as Postscript or Adobe PDF. In addition, each document may contain more than one page, wherein each page is annotated independently of the other. The documents and associated annotations are treated independently from each other. Separate data structures are created for the documents and for the associated annotations thus permitting their independent management* (Column 6, lines 32 – 43), which provide that ***a first set of data causing the browser to render on the display a fixed representation of a document.***

Eintracht et al. do not explicitly teach ***DHTML***. However, Madrane teaches that *another expected change concerns the edition of the HTML annotations. An in-place HTML editor should be used for allowing the user to directly modify the annotation HTML, in WYSIWYG mode, without launching any external editor. Microsoft's DHTML editor is the*

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preferred one (Column 29, lines 15 – 19), which provide that; ***a second set of data that has been generated by DHTML manipulation, said second set of data can be displayed by the web browser as annotation to the fixed representation of the document.*** It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Eintracht et al. with that of Madrane because such a combination would allow the users of Eintracht et al. the benefit of a *managing media files, creating and authoring media containers, publishing and indexing media containers, searching and browsing media containers, and distributing media containers* (Column 1, lines 11 – 14).

21. ***Regarding dependent claims 20 and 22***, Eintracht et al. teach that a user may *annotate many documents at the same time by opening several web browser windows. In addition, other clients can annotate either the same document or other documents at the same or a later time. In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each* (Column 2, lines 47 – 55), which provide that ***said second set of data constitutes a layer to the fixed representation of the document.***

Response to Arguments

22. Applicant's arguments filed 11/24/04 have been fully considered but they are not persuasive.

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23. In response to Applicant's argument that Eintracht does not teach the claimed feature(s) of claim 1, it should be noted that Eintracht does read on the invention as claimed. Specifically, the plug-in modules disclosed by Eintracht reads on the file comprising ... ***a second set of data which causes the web browser to make available to the user at least one annotation tool donating to the web browser an annotation functionality*** because even if the plug-in modules are "distinct" from the file, the file must contain a set of data, e.g. anchor codes, about the modules so that they will run properly.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, ***THIS ACTION IS MADE FINAL***. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER